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Applicant : GIEFER
Serial No : 09/600,832
Confirm. No : 2069
Filed : July 21, 2000
For : SLOT COVER...
Art Unit : 3682
Examiner : V. Luong
Dated : June 24, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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PETITION TO THE DIRECTOR UNDER 37 CFR 1.81

This Petition is in response to the communication from the U.S. Patent Office dated June 7, 2005.

In this communication, the Examiner states in paragraph 4 section (a), that the proposed Figure 4 does not show the reference numeral 20 as stated in the replacement paragraph on page 6 of the specification. Applicant notes that the reference numeral 20 is shown in the proposed new Figures 6 and 7. Reference 20 describes a direction, and this direction would be out of the page in the view of Figure 4. It is Applicant's position that the direction 20 is best shown in Figures 6 and 7. Applicant also notes that the specification does not specifically state that the direction 20 is shown in Figure 4. Therefore it is Applicant's position that the proposed Figure 4 is in compliance with U.S. Patent Regulations, and respectfully requests that the Director overrule this objection.

In section 4 (b) of the above mentioned communication, the Examiner indicates that the proposed amendments in the specification and the replacement sheet of drawings raise the issue of new matter.

The first point of new matter is with regard to the selection lever 8 being connected to the kinematics 17. The Examiner states that the original specification does not disclose that the lever 8 is connected to the kinematics. The Examiner then states that the original disclosure (claim 1) implies that the lever 8 may or may not be connected to the kinematics 17.

Applicant notes that if claim 1 indicates both possibilities of the lever being connected to the kinematics and the lever not being connected to the kinematics, then claim 1 implies that the lever may be connected. Since claim 1 implies both possibilities, the selection lever 8 being connected to the kinematics 17 is disclosed in the original application. Applicant respectfully requests that the director overrule this objection and indicate that the description is therefore not new matter.

In section 4 (b) of the communication, the second point appears to indicate that the amendments to the specification and claims regarding the "elastic portion 12, the hall sensors 14, permanent magnets 13 and bracket 15" are new matter. Applicant notes that the existence of these features does not appear to be new matter, but instead the particular characteristics of these features are new matter when they were added to the drawings and specification. In particular once these features were added to the drawings, as required by the Examiner under 35 CFR 1.84 and 1.83 (a), the Examiner indicated that the changes to the drawings made in accordance with these regulations was new matter. Applicant notes that the original disclosure

broadly set forth these features, and therefore disclose all possible characteristics and variations of these features. The changes to the drawings, are therefore not new matter but show one possible embodiment of these features, in order to comply with U.S. Patent drawing requirements. It is Applicant's position that a person of ordinary skill in the art would realize that the changes to the drawings are covered by the original disclosure. It is also Applicant's position that the person of ordinary skill in the art would be able to make or use the invention based on the original disclosure, and in making or using the invention, would embody the features in question in the same or similar manner as shown in the proposed drawings. Therefore the changes to the drawings are not new matter, but only a reasonable interpretation of one embodiment of the original structure.

Applicant notes that the Board of Appeals has decided that these structures are sufficiently described in the application so a person of ordinary skill in the art could make and use these structures. It is also Applicant's position that the changes to the drawings do not depart from the original disclosure. Therefore the changes to the drawings cannot be new matter.

In the previous objections to the drawings, two court cases were cited as support for the new matter rejection. Applicant has reviewed these court cases, and notes that the case of "Ex Parte George 203 USPQ" had refused to sustain many of the 112 and new matter rejections. Applicant further notes that the rejections that were sustained in these court cases were only related to claims. The courts felt that new matter was present when the feature was only broadly described originally, and later narrowly claimed.

This is not the situation with the present application. The changes to the drawings do not, and are not, intended to narrow the claims. Instead the drawings show an embodiment of the features described in the specification and claims. Since the changes to drawings do not relate to a narrowing of the claims, the court decisions do not support the new matter rejections.

For all of the above reasons, the Director is respectfully requested to overrule the objections raised by the Examiner with regard to the original disclosure, or to allow Applicant's proposed amendments to the specification and claims to be entered in order to overcome the objections.

Should additional facts be pertinent in this application, or additional changes are found out to be acceptable in this application, the U.S. Patent Office is requested to contact Applicant's representative by telephone to further discuss this application.

Favorable action is respectfully requested.

Respectfully submitted
for Applicant,

By: 

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